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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,365	09/26/2003	Chris Savarese	06196.P002	3038
7590 11/16/2007				
James C. Scheller, Jr. BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026		EXAMINER BANTA, TRAVIS R		
		ART UNIT 3714		PAPER NUMBER
		MAIL DATE 11/16/2007		DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/672,365

Applicant(s)

SAVARESE ET AL.

Examiner

Travis R. Banta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 128-141 and 147-149 is/are pending in the application.
- 4a) Of the above claim(s) 142-146 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 128-141, and 147-149 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant filed amendments to the claims on 8/22/2007. Claims 128, 133, 136, 137, and 148 are amended. Claims 1-127, and 142-146 have been canceled. Claims 128-141, and 147-149 are pending.

### ***Claim Rejections - 35 USC § 112***

Claims 128-135, 137, 147 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Amendment dated 8/22/2007 has amended claim 128 to incorporate material not present in the specification. Specifically, claims 128 and 137 (using similar language) recite "an outer spherical surface and having a first void recessed below the outer spherical surface". There is no recitation in the specification of the void being recessed below an outer spherical surface. Indeed, the words recess, recessed, and below (in this context) are not found in the specification. The claim as written incorporates new matter describing the void recessed below the outer spherical surface.

The Examiner has diligently searched the specification and has found no support for the word recessed or below the outer spherical surface. In other claims, for

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example, claim 129, the outer spherical surface is referred to as a shell. The Examiner recommends the Applicant amend the term "outer spherical surface" to "shell".

Additionally, the Examiner suggests the Applicant incorporate the material of claim 130 into that of 128. The Applicant has not disclosed his invention to function without the semiconductors, antennas, where the first antenna is orthogonal to the second antenna to be a non-essential part of the Applicant's invention. Thus claim 128 is overly broad is rejected under 35 U.S.C. 112 for enablement as well.

Claims 129 –135 are rejected for being dependent on the rejected base claim and incorporating the new matter and enablement issues by their dependency.

Claim 139 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "high durability" and "substantially complies with golf ball specifications of the United States Golf Association" are indefinite. There is no metric as to how one defines "high durability" past just "durability". Additionally, the specifications for golf balls according to the United States Golf Association are subject to change at any time which renders the claim indefinite.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 136-138, 140-141, and 147-149 are rejected under 35 U.S.C. 103(a) as being unpatentable over Little (U.S. 5,626,531) in view of Horchler (U.S. 3,782,730).

Regarding claim 136, Little discloses a golf ball component comprising a spherical material having a first void on an outer surface of the spherical material (see figure 1). Little further discloses an equivalent of an adhesive material between the base of the first void and a transponder. One of ordinary skill in the art would recognize an adhesive is equivalent to the "force fit" (column 1 line 64) disclosed by Little. Little fails to disclose a semiconductor disposed inside the void but does disclose a passive transponder disposed in the void. However, in a related device, Horchler discloses the use of a semi-conductor integrated circuits disclosed within a golf ball. One of ordinary skill in the art would recognize that the natural progression in the art of semi-conductor integrated circuits would shrink the size and improve the quality of the design. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to use a semiconductor integrated circuit contemporary with the Little disclosure because of the shrunken size and increased durability.

Regarding claim 137, Little fails to disclose a semiconductor. Horlacher, however, does disclose a semiconductor integrated circuit as has been combined with Little above. One of ordinary skill in the art would recognize the description of the integrated circuit in Horlacher on column 2 line 63 would satisfy as a semiconductor including an integrated circuit as recited by the claim.

Regarding claim 138, Little fails to disclose a semiconductor. Horlacher however, does disclose a semiconductor integrated circuit as has been combined with little

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above. Further, Horlacher discloses a part of the semiconductor integrated circuit a transmitting coil (labeled L in figure 1) as an antenna forming a tag.

Regarding claim 140, Little discloses an antenna made of an elastic conductive material (column 1 line 66 through column 2 line 2).

Regarding claim 141, Little discloses a tag. Horschler discloses a first tag and semiconductor integrated circuit with a first antenna. Little and Horschler fail to disclose a second tag having a second semiconductor with antennas positioned orthogonally. An antenna is considered equivalent to a radial transmission line. However, one of ordinary skill in the art would recognize that a wider antenna field would be created by an orthogonal positioning of a second antenna relative to the first. One of ordinary skill would recognize this is using well known principles of antenna design to create a wider electromagnetic field to improve reception and therefore performance. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to incorporate a second antenna to increase reception.

Regarding claim 148, Little discloses a golf ball component comprising a spherical material having a first void on an outer surface of the spherical material (see figure 1). Little further discloses an equivalent of an adhesive material between the base of the first void and a transponder. One of ordinary skill in the art would recognize an adhesive is equivalent to the "force fit" (column 1 line 64) disclosed by Little. Little fails to disclose an electrical component disposed inside the void but does disclose a passive transponder disposed in the void. However, in a related device, Horschler discloses the use of an electrical component disclosed within a golf ball. One of

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ordinary skill in the art would recognize that the natural progression in the art of electrical components would shrink the size and improve the quality of the design. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to use an electrical component with the Little disclosure because of the shrunken size and increased durability.

Regarding claim 149, Little fails to disclose an electrical component. Horlacher however, does disclose an electrical component as has been combined with little above. Further, Horlacher discloses a part of the electrical component is a transmitting coil (labeled L in figure 1) as an antenna forming a tag.

Claims 136-138, 140-141, and 148-149 are rejected under 35 U.S.C. 103(a) as being unpatentable over Little (U.S. 5,626,531) in view of Horschler (U.S. 3,782,730) further in view of Terry ( U.S. 5,820,484)

Regarding claim 139, The combination of Little and Horschler is made above. Little and Horschler fail to disclose a hand held transmitting and receiving device. Terry discloses a hand held transmitting/receiving device to detect a tag over a range (column 4 line 12). One of ordinary skill in the art would recognize it would be advantageous to incorporate a handheld display into the inventions of Little and Horschler to provide a means for tracking balls in the field of play. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to incorporate a handheld transmitting and receiving device to allow players to find balls in the field of play. It would be further obvious to allow a player a range of at least 20 feet to find a golf ball lost in play to put the player within a margin of error of where the ball is estimated to be and allow the

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player to find the ball. It would be further obvious to the ordinarily skilled artisan to make the ball highly durable, and substantially comply with specifications of the United States Golf Association to allow for repeated use, and practice with a ball that would be similar to balls allowed in tournament play.

### ***Response to Arguments***

Applicant's arguments with respect to claims 128-141, and 147-149 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



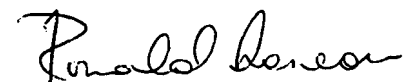
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis R. Banta whose telephone number is (571) 272-1615. The examiner can normally be reached on Monday-Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TB



RONALD LANEAU  
PRIMARY EXAMINER

11/13/07